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### REMARKS

The Applicant notes with appreciation the Examiner's thorough review of the present application as evidenced by the Office Action. The Applicant has provided remarks below, in response to the rejections in the Office Action. In light of the amendments above and the remarks that follow, the Applicant respectfully submits that all the claims of the application are patentable and in condition for allowance.

### CLAIM AMENDMENTS

Claims 22-31 were filed by preliminary amendment in this continuation application.

Claims 32-44 were submitted in response to an Office Action.

In independent claim 32, after the phrase "said machine comprising two mold carriers" please insert the phrase – **which are made in the form of enveloping structures and –**.

In independent claim 38, after the phrase "said machine comprising two mold carriers" please insert the phrase – **which are made in the form of enveloping structures and –**.

### RECAPTURE REJECTION

- A. The Shell Holders – as Claimed in Independent Claims 22, 27, 32 and 38, as Amended – Include the Mold Carrier Shape Limitation.

The pending claims do not recapture surrendered subject matter because the mold carrier shape continues to be a required characteristic.

The mold assembly recited in independent claim 22 includes two mold shell holders "shaped to be supported by two mold carriers made in the form of enveloping structures." The article recited in independent claim 27 includes a mold shell fixed with respect to a mold shell holder, the shell holder being "shaped to be supported by one of a pair of mold carriers made in the form of enveloping structures."

The mold shell recited in independent claim 32, as amended, refers to its use with a machine comprising two mold carriers "which are made in the form of enveloping structures."

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The shell body recited in independent claim 38, as amended, refers to its use with a machine comprising two mold carriers "which are made in the form of enveloping structures."

The claims include the mold carrier shape limitation, which is precisely the substance of the amendment made during prosecution of the original patent application.

B. The Surrendered Subject Matter Involves the Mold Carrier Shape, Not the Mold Carrier Itself.

During prosecution of the original patent application, claim 1 recited a device for manufacturing containers including at least one mold assembly, which consist of two half-molds respectively supported by two mold carriers, wherein each half-mold comprises a shell and a shell holder. The claim amendment entered during the original prosecution altered only the mold carrier shape. The mold carriers were present as elements of the combination before the amendment in question.

Thus, only the mold carrier shape was amended to overcome the prior art. Claim 1 of the original patent was amended to add the phrase, "which are made in the form of enveloping structures and" and to delete the phrase – in particular bottles –. Following the amendment, a Notice of Allowability was mailed and the '560 patent issued. The subject matter surrendered during prosecution of the machine claim was: a device without the enveloping characteristic of the mold carriers.

The suggestion that the "two mold carriers" limitation represents the surrendered subject matter is not supported by the facts from the original prosecution. The mold carriers were not added to claim 1 in order to overcome a prior art rejection. Only the mold carrier shape was amended. The recapture rule only prevents recovery of the surrendered subject matter; nothing more. The distinguishing characteristic of "mold carriers made in the form of enveloping structures" is present in both the original patent claim and the reissue claims. Because the amended feature remains present in the reissue claims, there is no recapture.

The examiner contends that the claim language "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with

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respect to the other” does not actually limit the structure of the shell holders. The Applicants disagree. This limitation excludes from coverage all shell holders that cannot be supported by mold carriers that have the required enveloping characteristic.

C. In View of the Exact Subject Matter Surrendered and the Broadening Aspect of the Change in Statutory Category, the Record Shows No Recapture.

The pending claims in this continuation application do not recapture surrendered subject matter. The claims, as amended, fall squarely into the paragraph 3(b) of the *Clement* test. Paragraph 3 states: If the reissue claims are broader than the surrendered subject matter in some aspects and narrower than the surrendered subject matter in other respects, and [subparagraph (b)] if the reissue claims are narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule will not bar the reissue claims. *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 2003 WL 21542454, at \*13 (BD. PAT. APP. & INTERF. May 29, 2003); *In re Clement*, 131 F. 3d 1464, 1469-70 (Fed. Cir. 1997).

- Applying Paragraph 3: The reissue claims are narrower than the patent claim prior to amendment (*i.e.*, narrower than the surrendered subject matter) in that the ability of the shell holders to be supported by mold carriers in the form of enveloping structures continues to be required in the reissue claims.
  - The reissue claims are also broader than the surrendered subject matter because the reissue claims are directed to an article of manufacture instead of a machine. *See* MPEP § 1412.02.
- Applying subparagraph (b): The narrowing aspect (continuing to require the enveloping characteristic of the mold carriers) is germane to the rejection because the shape was limited by amendment and remains a limitation of the shell holders in the reissue claims. There are many types of mold carriers, only some of which are made in the form of an enveloping structure.

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- The broadening aspect (claiming the article corresponding to the machine) is not germane to the rejection, because a change in statutory category is not germane to the rejection, and because the article claim is patentable over the prior art as determined by the examiner during prosecution of the reissue application.

Accordingly, under *Clement* and *Ex parte Eggert*, the requirements of paragraph 3(b) of the *Clement* test are satisfied and the recapture rule does not bar the reissue claims.

The enveloping mold carrier shape limitation is present in the claims being sought in the reissue application. The change in statutory category resulting from claiming the invention as an article of manufacture instead of a machine is a broadening aspect not germane to the rejection. Because there is no recapture of surrendered subject matter and the reissue claims are broader in an aspect unrelated to the rejection, the reissue claims are not barred by the recapture rule. Moreover, because the reissue claims are patentably distinguishable and allowable over the prior art, the reissue claims are in condition for immediate allowance.

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### CONCLUSION

After entry of the requested amendment, claims 22-44 are pending in the application. In light of the amendments and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

The Applicant does not believe any fees for extensions of time or net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any required fees (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account Number 16-0605.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination.

Respectfully submitted,



J. Scott Anderson  
 Registration No. 48,563

Customer No. 00826

ALSTON & BIRD LLP  
 Bank of America Plaza  
 101 South Tryon Street  
 Suite 4000  
 Charlotte, NC 28280-4000  
 Atlanta (404) 881-7000  
 Fax (404) 881-7777

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#### CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to (571) 273-8300 at the U.S. Patent and Trademark Office on this, the 15<sup>th</sup> day of September, 2005.

  
 Shana Moore